REMARKS

Applicant thanks the Examiner for her indication that Applicant's Reply to the Requirement for Information is sufficient. Claims 1-20 are pending in the application. Claims 1-20 stand rejected under the enablement requirement of 35 U.S.C. § 112, First Paragraph; claims 1-20 stand rejected under 35 U.S.C. § 101. These rejections are respectfully traversed for the reasons set forth below.

Claims 1-20 Meet the Enablement Requirement of § 112

The Examiner asserts that claims 1-20 do not meet the enablement requirement of 35 U.S.C. § 112, First Paragraph. Specifically, the Examiner points to three limitations in claim 1 that she believes are not enabled. Applicant respectfully disagrees, and traverses for the reasons set forth below.

The enablement requirement of 35 U.S.C. § 112, First Paragraph, requires that the specification of a patent application must contain a written description of the invention which enables a person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention. However, the specification need not teach, and may assume, that which is common and well known to persons skilled in the relevant art. Mowry v. Whitney, 81 U.S. (14 Wall.) 620, 623 (1871). "[S]kill in the art can be relied upon to supplement that which is disclosed as well as to interpret what is written." Rengo Co. Ltd. v. Molins Mach. Co., Inc., 657 F.2d 535, 549 (C.A.N.J. 1981) (citing In Re Bode, 550 F.2d 256 (C.C.P.A. 1977)).

The Examiner asserts that the claim limitation "establishing a first independent variable and a second independent variable..." is not enabled. Applicant strongly disagrees. Firstly, the meaning of the term "independent variable" and how to "establish variables" are well understood by those skilled in the art. Indeed, the term "independent variable" is even defined in Webster's Ninth New Collegiate Dictionary, 1990 Merriam Webster Inc. The term is defined therein as "a mathematical variable whose value is specified first and determines the value of one or more other values in an expression or function < in $Z=X^2 + 3XY+Y^2$, X and Y are independent variables>".

Secondly, with respect to the assertion in the office action that the Applicant does not describe how to "establish a first independent variable and a second independent variable related to the value of said specific intangible interest," Applicant directs the Examiner's attention to the following disclosure in the specification of the present application. Each of the following portions shows examples of the selection of independent variables related to the value of a specific intangible asset of interest.

At page 6, line 18, through page 7, line 15, the specification teaches how to select independent variables, and gives examples of same. Figures 1a, 1b, 1c, 1d, 4a, 4b, 5, 6, 8, 10, 11 and 12 include examples of independent variables that have been selected. See also the discussion of each of those drawings throughout the specification. As will be understood from the above-recited disclosure, and particularly from the disclosure at page 7, lines 14-15, the step of establishing first and second independent variables is the selection of at least two independent variables.

It is respectfully asserted in view of all of the above that the specification meets the enablement requirement of 35 U.S.C. § 112 with respect to the claim limitation

"establishing a first independent variable and a second independent variable...." Applicant further incorporates into this Reply the arguments presented by Applicant at pages 13-14 of the Response filed November 5, 2004, which were sufficient to overcome this same § 112 rejection three years ago.

The Examiner further asserts that the claim limitation "establishing a series of performance criteria statements..." is not enabled. Applicant strongly disagrees. The Examiner's attention is directed to the following disclosure in the specification of the present application. Page 7, line 10, to page 10, line 5, teaches how to establish performance criteria statements, and discloses examples of same. FIG. 2 provides examples of twenty (20) different performance criteria statements. As set forth in Applicant's prior response, that clearly discloses a selected *series* of performance criteria statements. Furthermore, it will be clear from page 7, lines 10-14, and from the face of claim 1 as-filed, that these are statements probative of the value of the first and second variables chosen. As noted by the Examiner, in addition to the many examples of selected performance criteria shown in the specification, the specification discloses that a human could select them or that a database could be used. It is respectfully asserted that a person skilled in the art could select performance criteria statements from a database or other source without undue experimentation.

With respect to the Examiner's statement that Applicant does not provide steps as to how to perform the step of establishing performance criteria statements, it is respectfully asserted that a person skilled in the art would certainly understand how to establish the same in view of (a) Applicant's twenty (20) examples in FIG. 2, (b) the disclosure at page 7, line 10, to page 10, line 5 of the specification, and (c) the limitation

requiring that they are statements "probative of the value of the first and second variables chosen."

It is respectfully asserted in view of all of the above that the specification meets the enablement requirement of 35 U.S.C. § 112 with respect to the claim limitation "establishing a series of performance criteria statements…." Applicant further incorporates into this Reply the arguments presented by Applicant at pages 14-15 of the Response filed November 5, 2004, which were sufficient to overcome this same § 112 rejection three years ago.

With respect to the claim limitation "scoring each of said performance criteria statements to produce a plurality of scores which reflect the applicability of said performance criteria statements to said specific intangible asset of interest," the Examiner's attention is directed to the following disclosure in the specification of the present application. FIG. 3; page 3, lines 12-13; page 5, line 7; page 5, lines 18-19; FIG. 6; page 10, line 7, to page 11, line 12; page 13, line 18, to page 15, line 10; FIG. 9; and page 16, line 11, to page 17, line 6. Applicant notes particularly the performance criteria scoring form of FIG. 3, the description at page 13, line 18, to page 15, line 10, regarding computerized scoring processes, the spreadsheet of FIG. 9 illustrating the results of a computer calculation of scores, and the description of that computer calculation at page 16, line 11, to page 17, line 6. These portions of Applicant's disclosure clearly teach a person skilled in the art how to score each of a series of performance criteria statements to produce a plurality of scores their applicability to a specific intangible asset of interest.

Furthermore, Applicant strongly disagrees with the Examiner's assertion that:

> [t]he issue remains as to how an evaluator scores each of said performance criteria statements other than randomly selected [*sic*] the statement that he think [*sic*] best describes the organization or asset being evaluated.

To the contrary, the disclosed selection step is clearly not random. In accordance with the specification and the claims, each of the performance criteria statements are scored based on the applicability of the performance criteria statement to the specific intangible asset of interest. From the many examples of the scoring step shown in the portions of the specification listed above, a person of ordinary skill in the art could certainly score performance criteria statements in accordance with the "scoring step" of the present claims without undue experimentation.

It is respectfully asserted in view of all of the above that the specification meets the enablement requirement of 35 U.S.C. § 112 with respect to the claim limitation "scoring each of said performance criteria statements to produce a plurality of scores which reflect the applicability of said performance criteria statements to said specific intangible asset of interest."

Claims 1-20 Meet the Statutory Subject Matter Requirement of § 101

The Examiner asserts that claims 1-20 do not meet the statutory subject matter requirement of 35 U.S.C. § 101. In particular, the Examiner asserts that the invention does not meet Section 101 because it does not produce a concrete result. The rejection is respectfully traversed for the reasons set forth below.

Section 101 states that whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement

thereof, may obtain a patent therefor. The Federal Circuit has ruled that a process is patentable under Section 101 if it produces a 'useful, concrete, and tangible result'. State Street Bank & Trust Co. v. Signature Financial Group, Inc. 149 F. 3d 1368, 1373-74, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998).

The concrete and tangible result of the presently recited invention is set forth in the penultimate steps of claim 1, which are reproduced below for reference:

> using a printer to transform physical media into a chart by physically plotting on said media a first axis relating to said first variable and a second axis relating to said second variable;
>
> using said printer to physically plot a point on said chart, said point being located at coordinates corresponding to said first and second total scores, respectively....

Applicant is perplexed as to how the Examiner could interpret the above steps as anything but a concrete and tangible result. In transforming physical media into a chart by physically plotting first and second axes on the media, and then physically plotting a point on the chart at coordinates corresponding to total scores generated in previous steps of the process, the claimed process unquestionably produces a concrete and tangible result, and meets the requirements of Section 101.

In Re Swartz is again cited by the Examiner for the proposition that where an asserted result produced by the claimed invention is "irreproducible" the claim should be

rejected under Section 101. Applicant asserts that In Re Swartz is clearly distinguished from the present facts.

The Examiner has woefully mischaracterized Applicant's arguments regarding In Re Swartz. In particular, the Examiner's statement that "Applicant argues that the claimed invention is not directed toward cold fusion, and therefore satisfies the requirement for providing a concrete result" is misplaced. On the contrary, Applicant's argument is as follows. The invention in In Re Swartz related to cold fusion. The PTO provided substantial evidence that those skilled in the art would "reasonably doubt" the asserted utility and operability of cold fusion. The Examiner found that the inventor had not submitted evidence of operability that would be sufficient to overcome reasonable doubt. The Federal Circuit found that the *utility* requirement of Section 101 mandates that the invention be operable to achieve useful results, and that the claimed invention did not meet that *utility* requirement because it was *inoperative*. In particular, Swartz' claimed invention could not reproducibly generate cold fusion, and therefore did not meet the utility requirement of Section 101. See In Re Swartz, 232 F. 3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 200).

There is no reasonable doubt with respect to the present application that the invention is operable. Nor has there even been any assertion of inoperability to produce the claimed result. The present invention, unlike Swartz' cold fusion invention, works. The claimed invention will always result in physical media with two axes physically plotted thereon, and a point physically plotted at coordinates corresponding to total scores generated in previous steps of the process. The presently claimed invention is, therefore, clearly reproducible.

The Examiner argues that:

> Each time a user goes through the method, they could chose different independent variables, performance criteria, and scoring for the same intangible asset. Thus, the result would be different each time the method is performed. This is not a concrete result because it is not repeatable or predictable.

While the appearance of the resulting transformed physical media may indeed differ between one implementation and another depending upon the particular scores generated in accordance with previous steps in the process, the claimed process reproducibly results in physical media with two axes physically plotted thereon, and a point physically plotted at coordinates corresponding to such scores. Thus, the claimed process is clearly not "irreproducible" under In Re Swartz.

Applicant notes in this regard that In Re Swartz does not require that the exact same result be produced every time the invention is practiced, but rather that one skilled in the art can reproduce the asserted result of the invention (in Swartz' case, cold fusion) without undue experimentation. The results in the present invention (the transformation and plotting set forth in the penultimate steps of claim 1), can be reproduced without undue experimentation.

In view of all of the above, it is respectfully submitted that the rejection under 35 U.S.C. § 101 must be withdrawn.

For the Examiner's convenience, Applicant submits herewith as "Exhibit A" a copy of the decision in In Re Swartz, 232 F. 3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 200) with Lexis headnotes.

CONCLUSION

Having fully complied with the Requirement for Information, it is submitted that claims 1-20 are in condition for allowance and Notice to that effect is respectfully solicited. In the event that the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, she is courteously requested to contact applicant's undersigned representative.

Respectfully submitted,

/Richard E. Kurtz/Reg. #33,936

Richard E. Kurtz, II (Reg. No. 33,936)
Attorney for Applicants

GREENBERG TRAURIG
1750 Tysons Boulevard, 12th Floor
McLean, VA 22102
(703) 749-1330
E-mail: kurtzr@gtlaw.com

Filed: November 5, 2007